

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. BOX 1451
Alexandria, Virginia 22313

Mailed: December 2, 2004

Opposition No. 91159885

Schlage Lock Company

v.

Alto Products, Corp.

Karen Kuhlke, Attorney:

This case now comes up for consideration of the parties' cross-motions to compel further discovery responses. The motions have been fully briefed.

The Board first takes up applicant's motion filed on September 20, 2004. By its motion, applicant seeks further responses to document requests nos. 15-18, 21-28, 30, 31, 34, 49, 51, 63, 64 and 65 from the first set of requests and document requests nos. 2, 3, 5, 6 and 7 from the second set of requests. In its response, opposer states that it has already forwarded its further responses as evidenced by an attached letter dated September 22, 2004, rendering much of opposer's motion moot. In addition, opposer argues that applicant did not meet the good faith requirements of Trademark Rule 2.120(e) inasmuch as applicant demanded that opposer produce its confidential documents "immediately," on

September 9, 2004, the date the parties' protective agreement was entered into the case. Opposer contends that this "demand was unreasonable" as was applicant's "lack of effort to work with opposer to resolve their differences." No reply has been received by the Board.

In view of opposer's representation that it has now served its supplemental discovery responses in light of the entry of the protective agreement, applicant's motion is **denied** as moot as to document requests nos. 15-18, 21-28, 31, 34, 49, 51 from the first set of requests and document requests nos. 3, 5, 6, and 7 from the second set of requests.

The Board now turns to the remaining requests in dispute. First, with regard to applicant's good faith effort, the Board finds that while it was not reasonable for applicant to demand "immediate" responses upon entry of the protective agreement with no follow up prior to filing the motion to compel, the Board finds equally disturbing, opposer's silence after applicant's September 9, 2004 letter. Under the circumstances of this case, the Board finds that applicant has minimally satisfied the good faith effort requirements of Trademark Rule 2.120(e).

With regard to document requests nos. 63 and 64, it is unclear if opposer has served responses to these requests that concern agreements between opposer and a third party.

Opposer only objected to these requests on the basis of confidentiality, and stated that it would produce responsive documents upon entry of an acceptable protective agreement. Settlement and contractual agreements between the responding party and third parties are discoverable. TBMP § 418(10) (2d ed. rev. 2004). In view of the above, applicant's motion is **granted** to the extent that opposer must produce documents responsive to document requests nos. 63 and 64.

Document request no. 65 reads: All litigation and other papers and things referred to in *DC Comics v. Kryptonite Corporation*. Opposer's response reads: Opposer objects to this request as vague, overbroad and incomprehensible. Information concerning litigation and controversies between a responding party and third parties based on the responding party's involved mark is discoverable. However, the only information which must be provided with respect to a legal proceeding is the names of the parties thereto, the jurisdiction, the proceeding number, the outcome of the proceeding, and the citation of the decision. TBMP § 418(10); *Johnson & Johnson v. Rexall Drug Co.*, 186 USPQ 167, 172 (TTAB 1975). In view thereof, opposer's objection to document request no. 65 is sustained and applicant's motion to compel is **denied** as to this request.

Finally, document request no. 2 reads: All document [sic] which show manufacture of products sold to automobile mechanics by opposer using KRYPTONITE. Opposer's response reads: Opposer objects to this request as overbroad, unduly burdensome, indefinite and irrelevant. The Board finds this request to be indefinite, opposer's objections are sustained and applicant's motion to compel is **denied** as to this request.

With regard to opposer's motion to compel filed on October 25, 2004, applicant has indicated in its response to the motion that documents were, in fact, produced prior to the filing of the motion to compel. Moreover, applicant included its response to the disputed requests in its response to the motion. No reply has been received by the Board. In view thereof, opposer's motion is **denied** as moot.

Discovery and trial dates are reset as indicated below.

DISCOVERY PERIOD TO CLOSE:	January 5, 2005
30-day testimony period for party in position of plaintiff to close:	April 5, 2005
30-day testimony period for party in position of defendant to close:	June 4, 2005
15-day rebuttal testimony period to close:	July 19, 2005

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